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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,199	03/29/2004	John J. Park	1022-2	5156

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EXAMINER	
WONG, STEVEN B	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/813,199	PARK, JOHN J.	
	Examiner	Art Unit	
	Steven Wong	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,7-10 and 12-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,7-10 and 12-14* is/are rejected.

7)☒ Claim(s) *15 and 16* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3, 4, 10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wei (6,500,077) in view of Balier (4,004,814). Note the basis of the rejections set forth in the Office Actions mailed February 25, 2005, August 4, 2005 and December 8, 2005.

3. Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wei (6,500,077) in view of Blair (4,004,814) and Robbie (5,672,118). Note the basis of the rejections set forth in the Office Actions mailed February 25, 2005, August 4, 2005 and December 8, 2005.

Response to Arguments

4. Applicant's arguments filed March 16, 2006 have been considered but are not persuasive. The applicant argues that the instant invention is directed to two distinctly claimed sections. Further, the applicant contends that, in Wei, the club does not strike the arm 3. The applicant argues that Wei teaches away from the arm being deformable and thus cannot anticipate a strike portion as claimed. The applicant adds that the tee of Wei is not intended to possess a strike portion and thus cannot inherently teach a strike portion. Finally, the applicant argues that Wei does not teach a support wire folded at a point as claimed. The applicant states that neither Wei nor Blair teach the wire having a fold at a point on the spoon shaped portion where the ball directly rests.

However, these arguments are not persuasive as the combination of Wei in view of Blair is still seen as teaching the claimed invention. The applicant argues that the instant invention is directed to two distinctly claimed sections, however, the instant claims fail to recite "two

distinctly claimed sections". Further, the tee of Wei is seen as providing two distinct sections extending from the tee.

Regarding the language "deformable strike portion", the arm (3) of Wei is still seen as being obviously capable of being termed a strike portion. The language "strike" relates to the intended use for the portion of the tee.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Even if the arm (3) of Wei is not intended to be struck by the club head, the limitation is taught by the arm (3) of Wei because it is obviously capable of performing the intended use. Nothing within the teachings of Wei would prevent the arm (3) from being struck by the user with a golf club head. Simply because the arm is not intended to deform due to the springs does not preclude the arm from being termed a strike portion. The applicant again relies on his own interpretation of what a strike portion should entail, however, this interpretation is not stated in the claims or the originally filed specification.

Regarding the claim language reciting the support wire that is "folded at a point", this language is taught by the combination of Wei in view of Blair. Both Wei and Blair teach bends in their arms. Note the definition for "fold" provided in the Office Action mailed February 25, 2005. The definition states that a "fold" is "a coil or bend, as of rope". Clearly, the wires of both Wei and Blair fulfill this definition because the wires are bent along their lengths to define the spoon shaped portion where the ball rests.

Regarding the rejection of claims 5 and 7-9 over Wei in view of Blair and Robbie, the applicant argues that one of ordinary skill in the art would not combine the teachings. The applicant states that Robbie is directed to a device that has an adjustable arm (30) that is intended to be raised or lowered so as to teach proper swing mechanics. The applicant contends that if the tee of Wei were placed on the vertical shaft of Robbie, the Robbie device would not be able to provide an adjustable height device. However, this argument is not persuasive as the references are still seen as being properly combined. The Robbie reference is relied upon merely for its teaching that it is well known in the golf art to provide self-supporting bases for teeing golf balls. The reference to Wei provide a shaft and attachment means between the strike portion and the shaft. However, the shaft of Wei is not self-supporting. It would have been obvious to one of ordinary skill in the art to replace the shaft with a self-supporting base (12, 14) in order to permit the tee of Wei to be used on hard surfaces that would not permit insertion of the golf tee.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Allowable Subject Matter

5. Claims 15 and 16 read over the prior art of record.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven Wong
Primary Examiner
Art Unit 3711

SBW
May 22, 2006